

## REMARKS

Applicants respectfully request reconsideration of the present application based on the following remarks. Claims 6-8 and 19-21 are rejected under the second paragraph of 35 U.S.C. §112 as allegedly indefinite, claims 1-5, 8-18 and 22-26 are rejected under 35 U.S.C. §102 as allegedly anticipated by U.S. Patent No. 6,678,821 to Waugh et al. (“Waugh”) and claims 6-8 and 19-21 are rejected under 35 U.S.C. §103 as allegedly unpatentable over Waugh in view of U.S. Patent No. 4,652,698 to Hale (“Hale”) and further in view of U.S. Patent No. 7,188,362 to Brandys (“Brandys”). Claims 27 and 28 were previously withdrawn as a result of a Restriction Requirement. Applicant traverses each and every rejection for at least the reasons set out below.

### ***The §112 Rejections***

The Office Action rejects claims 6 and 19 based on the Examiner’s misapprehension that the claims contain an inconsistency. Specifically, the Examiner supposes that pre-enrollment keys need not be supplied to key generators since key generators generate pre-enrollment keys. However, this supposition derives from a mischaracterization of the claims. Claim 6 requires, *inter alia*, generating pre-enrollment keys for the user, supplying the pre-enrollment keys to respective key generators, and generating a final enrollment key for the user only if keys provided by a key administrator match the pre-enrollment keys supplied to the key generators, the key administrator being a person different than the key generators. According to the claim language, a precondition for generating a final enrollment key is that pre-enrollment keys provided to a key generator match keys provided by a key administrator who is not one of the key generators. This claim language is both internally consistent and lucid. The Examiner is directed to one example taken from the specification that may be assist comprehension of the claim language:

As shown in steps S502-1 and S502-2, two authorized employees (Key-Generator-1 and Key-Generator-2) / (KG-1 and KG-2) from the service will access the enrollment process and provide the enrollment process with the user’s identifying information. The enrollment process then generates respective pre-enrollment keys and communicates them to the employees. In one example, the pre-enrollment keys are unique and randomly generated alphanumeric strings. Preferably, KG-1 and KG-2 will access the enrollment process separately to generate the pre-enrollment keys for every approved user/client.

KG-1 and KG-2 will then forward the pre-enrollment keys to the Key Generator Administrator and Certifier (KGAC) for generating and approval of the final enrollment key. An authorized employee from the

organization will be the KGAC. After the KGAC has entered prospective user's identifying information, the enrollment process will prompt KGAC for the two pre-enrollment keys already generated for the user. If this information is correct, the enrollment process will produce the final enrollment key, and if required, can further require a biometric signature to be supplied by the KGAC (S504). In one example, a proprietary program is used to generate the final enrollment key.

Specification, p18, lines 3-17. It is apparent that this passage provides an example in which KG-1 can supply pre-enrollment keys to a key generator (KGAC) who would generate a final enrollment key for the user only if the keys provided KG-2 match the pre-enrollment keys supplied by KG-1. Having considered this example, other examples provided in the Specification will be readily appreciated. Therefore, Applicants respectfully submit that the §112 rejections of claims 6 and 19 are improper and should be withdrawn.

The Office Action also rejects claim 7 and 20 apparently for the reason that the term “comparison” does not specify an object to which a final enrollment key is compared. Applicants disagree with the characterization of the claim language because comparison is a noun and does not require specification of the compared objects. Applicants have nevertheless amended the claims to require verifying registration of the user in accordance with a *validation* of the final enrollment key. It will be appreciated that one form of validation may be obtained by comparing a presented object with a known object to obtain a comparison of the presented object. Applicants submit that the amendments are fully supported in the Specification and Drawings, do not add new subject matter to the application and render moot the §112 rejections of claims 7 and 20.

### ***Claim Rejections under 35 U.S.C. §102***

Applicants respectfully traverse the §102 rejections of the claims for at least the reason that Waugh does not teach every aspect of the claimed inventions either explicitly or impliedly. A cited prior art reference anticipates a claimed invention under 35 U.S.C. §102 only if every element of the claimed invention is identically shown in the single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990). Waugh does not disclose each and every element of the claims arranged as they are in the claims.

More specifically, and with particular regard to claims 1 and 14, Waugh does not teach, *inter alia*, sending the collected biometric sample from the client to the authentication server and

comparing, at the authentication server, the biometric sample to a biometric template associated with the user. Instead, Waugh explicitly teaches downloading an ID template to a client computer (see Waugh col. 3, line 44 – col. 4, line 3), obtaining a fingerprint at the client computer, comparing the fingerprint with the template at the client computer and transferring a digital code between modules on the client computer if a match is found. These teachings are found in the Waugh specification and drawings as cited by the Examiner:

In order to use his private key to encrypt the message stored in the message storage module 40, the user downloads his ID template 801 from the ID template server in step 102. This ID template 801 is then stored in the 10 template storage module 42. As discussed above the ID template 801 includes a biometric standard 82 and a digital identifier 84. The biometric standard 82 is a record of a previously measured physical attribute of the user. Typically, this physical attribute would be a finger print, but could also be some other physical attribute, such as a voice print of a voice.

In step 104, the same physical feature as is recorded in the biometric standard 82 is measured by a biometric device to obtain a measured biometric value. In the embodiment of FIG. 1, the first biometric device 24 reads the fingerprint from the finger 36 of the first user in step 104. Then, in step 106, the biometric value comparison module 44 compares the biometric standard 82 stored on the ID template storage module 42 with the measured biometric value obtained by the biometric device 24 and stored in the measured biometric value storage module 50g. If there is a sufficient correspondence between the two biometric values, then the biometric value comparison module 44 instructs the ID template storage module 421 to send the digital identifier 88 to the key control module 46.

Specification, col. 5, lines 3-26 and see Waugh Figs. 1-2. Waugh expressly teaches that biometric readings are compared with previously recorded values *in its client computer 22*. See Waugh, Fig. 2 and col. 3, line 44 – col. 4, line 3. Consequently, the rejections of claims 1 and 14 and every claim which depends from claim 1 or claim 14 are founded on a misconception of the teachings of Waugh. In fact, the Waugh-taught process operates in an opposite manner to the claimed inventions and therefore teaches away from the claims. Specifically, the Office Action asserts that Waugh teaches sending a collected biometric sample to an authentication server and comparing the sample at the authentication server when Waugh explicitly teaches sending an ID template to a client computer and comparing a fingerprint collected at the client computer with the ID template on the client computer.

Therefore, Applicants submit that the rejections of claims 1 and 14 are improper and Applicants request withdrawal of those rejections.

Each of claims 2-13 and 15-26 ultimately depend from claim 1 or claim 14 and are allowable for at least the reasons claims 1 and 14 are allowable. Applicants submit that, given the degree of difference between the teachings of Waugh and the independent claims, the other deficiencies in claims 1 and 14 and their dependent claims need no further comment. Applicants note, for example, that each of claims 9-11 and 22-24 further limits its respective independent claim by specifying certain required attributes associated with sending a collected biometric sample from a client to an authentication server. Waugh does not teach sending a collected biometric sample from a client to an authentication server, but expressly teaches an opposite process of sending a biometric template to a client computer for comparison with a fingerprint obtained at the client computer. Consequently, it is improper to assert that Waugh teaches all elements as arranged in the claims of the present application. Therefore, for at least the reasons provided above, the §102 rejections of claims 2-5, 9-13, 15-18 and 22-26 are improper and these rejections should also be withdrawn.

***Claim Rejections under 35 U.S.C. §103***

The §103 rejections of claims 6-8 and 19-21 should be withdrawn for at least the reason that Hale and Brandys do not cure the deficiencies of Waugh discussed above and, consequently, no combination of the cited art teaches all elements of claims 6-8 and 19-21.

Furthermore, as cited, Hale and Brandys do not teach or suggest the elements acknowledged to be absent from Waugh, and Hale and Brandys do not teach certain elements and limitations of the claims as alleged by the Office Action. For example, the Office Action proposes that Hale's Abstract teaches: generating pre-enrollment keys; supplying pre-enrollment keys to plural key generators; generating a final enrollment key for the user only if keys provided by a key administrator match the pre-enrollment keys supplied to the key generators, the key administrator being a person different than the key generators; and verifying registration of the user in accordance with a validation of the final enrollment key. The Abstract of Hale does not teach **any** of these elements. Indeed, Hale never teaches or refers to keys (other than keyboard keys), key generators, key generation, key administrators, pre-enrollment or enrollment. The support offered by the Office Action does not identify the elements alleged to be present with particularity and the rejections are consequently so vague that they preclude cogent argument. Simply put, nothing in Hale bears sufficient resemblance to the limitations of the claims or the subject matter of the present Application to warrant direct argument.

The citations to Brandys are equally vague and irrelevant. The Office Action alleges that Brandys teaches creating the biometric template for a user only if registration is verified, generating a private key only if the biometric template is successfully created and associating user identification information with the final enrollment key. However, not only are these claimed steps not taught or suggested in Brandys, but no step bearing even a superficial resemblance to any of these claimed steps can be found in the reference. The recited order and preconditions recited in the claims are not described or suggested in relation to any other feature of Brandys. A few of the words used in the claims of the present invention can be found scattered in unconnected fashion throughout Brandys, but the construction of the Brandys teachings proposed in the Office Action is both arbitrary and fanciful and is apparently rooted in an unrestrained and improper application of hindsight.

Therefore, for at least these reasons, the §103 rejections should be withdrawn.

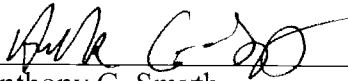
### **CONCLUSION**

All objections and rejections having been addressed, and in view of the foregoing, the claims are believed to be in form for allowance, and such action is hereby solicited. The Examiner is kindly requested to contact the undersigned at the telephone number listed below if any points remain in issue which may best be resolved through a personal or telephone interview.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,  
PILLSBURY WINTHROP SHAW PITTMAN LLP

Date: February 29, 2008

  
\_\_\_\_\_  
Anthony G. Smyth

Telephone: (650) 233-4802

Please reply to Customer No. 27,498

55,636  
\_\_\_\_\_  
(Reg. No.)